

REMARKS/ARGUMENTS

Status of the Application

Prior to entry of this amendment, claims 1-21 were pending in the application. An Office Action mailed September 30, 2005, objected to the drawings as failing to show every feature of the invention specified in the claims. The Office Action rejected claims 1-21 under the first paragraph of 35 U.S.C. § 112 as failing to comply with the enablement requirement and under the second paragraph of § 112 as being indefinite. The Office Action further rejected claims 1-21 under 35 U.S.C. § 102(e) as being anticipated by US Publication No. 2001/0037460 ("Porcari").

This amendment amends claims 1-5, 9-12 and 16-21, and adds new claims 22-30. No claims have been canceled. Hence, after entry of this amendment, claims 1-30 stand pending for examination. The Applicants respectfully request reconsideration of the claims for at least the reasons stated below.

Claim Amendments

Independent claims 1 and 16 have been amended to more particularly recite the subject matter to which the claim is directed. For example, in claims 1 and 16, the term "remote server" has been replaced with "data processing system comprising a first database." These amendments are supported throughout the application including, in particular, by Fig. 11 and the corresponding portions of the specification. Claims 1 and 16 also have been amended to recite "accessing the electronic document." Support for these amendments are found throughout the application including, in particular, at lines 14-26 on page 19 of the application. Claim 1 additionally has been amended to recite "accessing an electronic IDS corresponding to a patent application." Support for this amendment can be found throughout the application including, in particular, at element 510 on Fig. 5, as well as lines 20-34 on page 12 of the application and lines 1-20 on page 13 of the application. Claims 1 and 16 have been amended further to recite "adding the IDS information to an electronic IDS." Support for these amendments can be found

throughout the application including, in particular, at lines 9-26 on page 10 of the application. Claims 1 and 16 also have been amended stylistically for enhanced readability. It is believed that these stylistic changes do not narrow the scope of the claims.

Claims 2-5 and 9-12 have been amended for consistency with claim 1, from which they ultimately depend, and for enhanced readability. Similarly, claims 17-21 have been amended for consistency with claim 16, from which they ultimately depend, and for enhanced readability.

New claims 22-30 have been added. Claim 22 recites "wherein accessing an electronic IDS comprises creating the electronic IDS," and claim 26 recites "creating the electronic IDS." Support for claims 22 and 26 can be found throughout the application including, in particular, at elements 510 and 530 on Fig. 5, as well as lines 17-23 on page 12 of the application and lines 7-28 on page 13 of the application.

New claim 23 recites "wherein adding the IDS information to the electronic IDS comprises storing in the electronic IDS a pointer to the IDS information," while new claims 24 and 25 recite "wherein adding the IDS information to the electronic IDS comprises storing the IDS information in the electronic IDS." Support for these amendments can be found throughout the application including, in particular, at lines 9-26 on page 10 of the application.

Claims 27 and 28 are directed to computer systems for generating an electronic IDS, and they correspond to the methods recited by claims 1 and 16, respectively. Similarly, claims 29 and 30 are directed to software programs corresponding to the methods recited by claims 1 and 16, respectively. Support for claims 27-30 can be found throughout the application including, in particular, in claims 1 and 16, and the portions of the specification supporting those claims, as well as lines 24-32 on page 7 of the application.

Objections to the Drawings

The Office Action objected to the drawings on the grounds that the drawings failed to illustrate the claimed remote server with a database and the claimed associating steps. The Applicants respectfully traverse these objections. Merely by way of example, element 230 on Fig. 2 illustrates associating IDS information with an electronic IDS, and elements 1040 and 1041 on Fig. 10, as well as elements 1100 and 1106, illustrate servers with databases. Nonetheless, it is believed that the amendments to claims 1 and 16 overcome the objections to the drawings in any event, and the withdrawal of those objections is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1-21 under § 112, paragraph 1, as failing to comply with the statutory enablement requirement. In particular, the Office Action asserts “[i]t is not clear whether the remote sever and the database are part of the client system or not. It is also not clear how many associating steps are involved. The first associating the document with one or more patent case on the remote server and then the associating the IDS information with an electronic invention disclosure statement for the first patent case. Where does the IDS form come from? How are the documents associated with each other? How is the IDS document generated?”

The Applicants respectfully traverse the rejections under § 112, paragraph 1, and further submit that the amendments to claims 1 and 16 overcome the rejections. For example, claims 1 and 16 have been amended to recite a data processing system comprising a first database. The specification and figures (*see, e.g.,* Figs. 10 and 11) clearly define the relationship between the data processing systems and the client computers. In addition, the claims, as amended, no longer include the term “associating,” so it is believed that the rejections based on this term have been overcome. Reconsideration of the § 112, paragraph 1, rejections, therefore, is respectfully requested.

The Office Action also rejected claims 1-21 under 35 U.S.C. § 112, paragraph 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In particular, the Office Action notes “[t]he applicant uses the abbreviation IDS through out the claim language without first identifying what it means.” The preambles of claims 1 and 16 have been amended to define the term “IDS.” It is believed that these amendments overcome the rejections under § 112, paragraph 1, and the reconsideration of those rejections is respectfully requested as well.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claims 1-21 under 35 U.S.C. § 102(e) as being anticipated by Porcari. These rejections are respectfully traversed, for at least the following reasons. In order to anticipate a rejected claim, “a reference must teach every element of the claim.” MPEP § 2131. Porcari does not teach every element of any pending claim, and it is believed, therefore, that Porcari fails to anticipate any of claims 1-30.

The pending claims are drawn to systems, methods and computer programs for generating an information disclosure statement (“IDS”). In contrast, Porcari is directed to a system that “enables users to collaborate, create, review and approve documents and to communicate those documents to other parties. In one aspect of [Porcari’s] invention an on-line invention disclosure system includes a user computer and a web server having an identification subsystem.” Porcari, paragraph 0015. Hence, Porcari generally teaches the preparation of invention disclosures, not information disclosure statements.

Porcari does briefly mention that its “system optionally includes a system to reference prior art documents.” *Id.*, paragraph 0056; *see also Id.* paragraphs 0057-58. This brief disclosure, however, does not teach or suggest each element of any pending claim. Merely by way of example, claim 1 recites, inter alia, “receiving, at a data processing system comprising a first database, a signal from a client system, the signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office.” Porcari

does not teach or suggest this element. Paragraph 0044 of Porcari does describe a facility allowing a user to search “to give evaluators [who approve the invention disclosure for filing] a state of the art to assist in their evaluation,” and teaches that “after the search has been sufficiently refined, the results are stored together with the disclosure.” That disclosure does not teach “receiving a signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office,” as recited by claim 1.

Nor does Porcari teach “adding the IDS information to the electronic IDS,” as recited by claim 1. Instead, Porcari expressly speculates an XML-based disclosure statement, comprising links to references on other web sites (such as the USPTO web site), instead of IDS information. *See Id.*, paragraphs 0057-58. Hence, Porcari fails to teach or suggest multiple elements of claim 1 and claim 1, therefore, is believed to be allowable over Porcari.

Independent claim 16 includes similar limitations and, therefore, is believed to be allowable for at least similar reasons. Additionally, claim 16 recites “storing, in a reference table, a reference link to the electronic document” and “in a case table, linking a first case to the reference link.” Porcari fails to teach or suggest the concepts of either a reference table or a case table, let alone linking a first case to the reference link, as recited by claim 16. For at least this additional reason, claim 16 is believed to be allowable over Porcari.

Independent claims 27 and 29 recite elements similar to those of claim 1 and, therefore, are believed to be allowable for at least similar reasons. Likewise, independent claims 28 and 30 recite elements similar to those of claim 16 and are believed to be allowable for at least similar reasons. Accordingly, all of the independent claims in the application are believed to be allowable over Porcari.

Dependent claims 2-15 and 17-26 each depend ultimately from either claim 1 or claim 16 and are believed to be allowable at least because of their dependence from allowable base claims. Moreover, many of the dependent claims recite additional elements not found in Porcari.

Merely by way of example, dependent claim 2 recites “wherein the electronic document includes a plurality of fields for storing the IDS information, and wherein adding the IDS information to the electronic IDS comprises extracting the IDS information from each of the plurality of fields and storing the IDS information in a corresponding plurality of fields in the electronic IDS,” and claim 17 recites a similar element. Nothing in Porcari even approaches teaching or suggesting this element. Instead, as mentioned above, Porcari teaches, if anything, that the only information added to an IDS is a hyperlink to a reference on another web site. See Porcari, paragraphs 0056-57. This does not teach or suggest that an electronic document might include a plurality of fields for storing IDS information, or that such information might be extracted from each of the plurality of fields and stored in a corresponding plurality of fields, as recited by claims 2 and 17. Indeed, even if a hyperlink could be considered IDS information, one skilled in the art would appreciate that the hyperlink to an electronic document is not stored in a field in that electronic document (let alone in a plurality of fields) and, therefore, could not be extracted from such a non-existent field. It would be impossible for Porcari to operate in accordance with the elements of claims 2 and 17 and, for at least this additional reason, claims 2 and 17 are believed to be independently allowable over Porcari.

Dependent claim 3 includes elements similar to those found in claim 16, discussed above, and is believed to be allowable for at least similar reasons.

Dependent claim 5 recites “extracting the IDS information from the reference information.” Nothing in Porcari teaches or suggests this element, and claim 5 is believed to be allowable for at least this additional reason.


Dependent claim 18 recites “storing one or more cited reference links to a plurality of electronic documents in a cited references table, the cited reference links indicating that the plurality of electronic documents that have been cited to a patent office, wherein the IDS information is added to the electronic IDS only if the electronic IDS has a reference link in the reference table but does not have a cited reference link in the cited reference table.” Nothing in Porcari teaches or suggests a cited reference table, let alone that IDS information is added to an

electronic IDS only if the electronic IDS has a reference link but does not have a cited reference link. Claim 18 is believed to be allowable for at least this additional reason.

Conclusion and Request for Telephone Interview

In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested. If the Examiner continues to believe that the amended claims are not allowable over the cited reference, the undersigned hereby respectfully requests a telephone interview to discuss how the pending claims are patentably distinct from the cited reference. The undersigned can be reached at 303-571-4000 to schedule a telephone interview.

Respectfully submitted,


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